

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 6, 12, 14-20, 24-25, and 27 have been amended, claims 8-11, 13, 21-23, 26, and 28-30 have been cancelled without prejudice, and new claims 31-36 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC §103

Claims 1-5 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 6,296,350 to Cornell et al. ("Cornell") in view of U.S. patent 6,612,673 to Giere et al. ("Giere") and further in view of U.S. patent 6,398,333 to Mulay et al. ("Mulay"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143

discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 1, and its dependent claims 2-5, is respectfully traversed for at least the following reasons. Claim 1 recites:

“1. (Currently amended) A printing system, comprising:
an inkjet printhead having plural portions each having an ink-ejecting nozzle;
plural heater elements each associated with one of said plural portions to pre-warm ink dispensed by the nozzle of said associated portion in response to a pre-warming signal; and
a controller configured to
analyze an upcoming print swath to determine which of said plural portions are required to eject ink in order to print the swath in accordance with a predefined selection criteria,
and
supply the pre-warming signal to one or more heater elements of only the portions required to eject ink to print the swath in accordance with the predefined selection criteria.”
(emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

There is no teaching or suggestion in the Cornell or Mulay references that the controller analyzes an upcoming print swath to determine which portions of the printhead are required to eject ink to print the swath.

To whatever extent that the Giere reference may teach or suggest that the controller analyzes an upcoming print swath (col. 8, lines 20-26), the Giere reference does not teach or suggest that the analysis determines which of the plural portions of the printhead are required to

eject ink in order to print the swath in accordance with a predefined selection criteria, as recited in claim 1. No such predefined selection criteria is identified by the Office, or taught or suggested in the Giere reference.

Furthermore, the Giere reference does not teach or suggest supplying the pre-warming signal to only the portions required to eject ink, as recited in claim 1. In fact, the Giere reference teaches just the opposite: “The temperature logic system also generates firing voltages 814 and activates heater elements that do not eject ink 816” (col. 9, lines 17-19; Fig. 8; emphasis added).

In addition, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings, in that the Giere reference teaches away from Applicants' invention as recited in claim 1. Because the Giere reference teaches that heater elements that do not eject ink are activated as part of performing the pre-warming function, a person of ordinary skill in the art would be discouraged from taking the opposite approach recited in Applicants' claim 1, where the pre-warming signal is supplied to only those portions of the printhead that are required to eject ink. As such, there is no motivation to modify or combine the teachings of the Cornell, Giere, and Mulay references to arrive at Applicants' invention as recited in claim 1.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Formalities

Allowable Subject Matter

Claims 6-7, 12, 14-15, 17, 20, 24-25, and 27 have been objected to as being dependent

upon a rejected base claim and have been indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants acknowledge, with appreciation, the indication of allowable subject matter.

With this Amendment, Applicants have rewritten allowable claims 6, 12, 14-15, 17, 20, 24-25, and 27 in independent form to include all of the limitations of the base claim and any intervening claims. In addition, Applicants have amended claims 16 and 18-19 to depend directly or indirectly from rewritten independent claim 14. As rewritten claim 14 is now believed to be in allowable form, Applicants respectfully submit that dependent claims 16 and 18-19 are allowable in dependent form.

Applicants, therefore, respectfully request that the objection to claim 6-7, 12, 14-15, 17, 20, 24-25, and 27 be withdrawn, and that claims 6-7, 12, 14-15, 16-20, 24-25, and 27 be deemed allowed.

Comments on Statement of Reasons for Allowance

Applicants agree with the Office's conclusion regarding patentability, without necessarily agreeing with or acquiescing in the reasons set forth in the Office Action. In particular, applicants wish to emphasize that the patentability of claims stems from the respective combinations of elements defined by the claims, each viewed as a whole, rather than the presence of any particular elements in the combinations. Applicants submit that the indicated claims are allowable because the prior art fails to anticipate, teach, suggest, or render obvious the invention as claimed, independent of how the invention is paraphrased. Applicants thus rely on the claims, as drafted, rather than any characterization in the Office Action.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably

distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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